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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,783	11/21/2000	Sadashiv Adiga	182.1001.02	8548

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/717,783

Applicant(s)

ADIGA ET AL.

Examiner

Narayanswamy Subramanian

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/13/2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to applicant's communication filed on September 13, 2004. Amendments to claims 10-13 and 15, cancellation of claims 1-9 and newly added claims 27-43 have been entered. Rejection of claims 10, 12, 13, 16, and 19-26 under 35 USC § 101 is withdrawn by the examiner in view of the amendments. Also rejection of claims 11-13, 15 and 20 under 35 USC § 112, second paragraph withdrawn by the examiner in view of the amendments. Claims 10-43 are pending in this application and have been examined. The rejections and response to arguments are stated below.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

3. New claims 27-43 recite the limitation "System". It is not clear if the word "system" refers to a method or an apparatus. Clarification is required.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al (US Patent 5,924,082) in view of Odom et al (US Patent 6,058,379).

With reference to claims 10 and 27, Silverman teaches a method and system for automated negotiation, the method including steps for: identifying one or more parties (See Silverman Claim 39); setting the parameters of said automated negotiation (See Silverman Claim 39); and storing information in a database, wherein at least one of said steps is performed automatically by a computer program (See Silverman Figure 1, Column 6 lines 15-67 and Column 7 lines 31-33) A system including a processor, input and presentation elements that operate under control of said processor, a communication link that operates under control of said processor, and memory storing information including instructions are inherent in the disclosure of Silverman.

Silverman does not explicitly teach the steps of sending an invitation to said automated negotiation to one or more parties; making an offer in response to said invitation; and responding to said offer.

Odom teaches the steps of sending an invitation to said automated negotiation to one or more parties (See Odom Column 5 lines 48-50, sending e-mail implies sending an invitation to negotiate); making an offer in response to said invitation (See Odom Column 6 lines 27-30); and responding to said offer (See Odom Column 6 lines 30-60).

Both Odom and Silverman are concerned with the problem of finding suitable matches between buyers and sellers and facilitating them to negotiate and finalize the terms a transaction. It would have been obvious to one with ordinary skill in the art at the time of invention to include the disclosure of Odom to the invention of Silverman. The combination of the disclosures taken as a whole suggests that it would have helped the two negotiating parties reach an agreement in a timely manner.

With reference to claims 11-13 and 28-30, Silverman teaches the step wherein identifying counter-parties is performed automatically by a computer program that searches a database (See Silverman Column 7 lines 31-45, storage of bids/offers with their corresponding parameters implies a database and the matching step implies searching the database); identifying counter-parties is performed by the initiator of said automated negotiation (See Silverman Column 3 lines 40-43 and Column 7 lines 36-42); identifying counter-parties includes setting various parameters for access control and preferences so as to create private negotiations and private directories (See Silverman Column 3 lines 36-50, Column 8 line 66 – Column line 14) The second parameters are interpreted to include various parameters for access control and preferences so as to create private negotiations and private directories.

With reference to claims 14-15 and 31-32, Silverman teaches the steps of setting the parameters is performed by an initiator of said automated negotiation through a series of interactions with a computer program (See Silverman Column 7 lines 25-30); where in said series of interactions includes defining the type of said automated negotiation (See Silverman Column 3 lines 55-60); specifying terms for said negotiation that can be varied; and specifying a range over which said terms as can be varied (See Silverman Column 1 lines 18-22, Column 5 lines 49-53 and Claim 14).

With reference to claims 16-18 and 33-35, Odom and Silverman teaches a method and system of claims 10 and respectively, wherein said invitation includes information included in said parameters (See Odom Column 5 lines 45-50); where in said invitation is sent to said one or more parties using a computerized communication system (See Odom Column 5 lines 6-10 and

Art Unit: 3624

45-50); wherein said computerized communication system includes a wireless transmitter and receiver ((See Odom Column 5 lines 6-10).

With reference to claims 19-21 and 36-38, Silverman teaches the step of making an offer is performed by a party other than the sender of said invitation (See Silverman Column 4 lines 4-12) The invitation is sent by the matching system and the offer or counter offer is made by the bidding parties. Official notice is taken that the step of responding to an offer including accepting the offer, rejecting the offer or making a counter offer by the party that sent said invitation is old and well known in the art. This step facilitates negotiation between two parties and to agree on a settlement in a timely manner. Odom teaches the step of responding by the party that sent said invitation (In Odom's disclosure the seller sends the E-mail invitation and responds to the bids by the buyer).

With reference to claims 22-26 and 39-43, Silverman teaches the steps of storing information includes information concerning said automated negotiation (See Silverman Column 7 lines 30-33); step of storing information includes information regarding the relative performance of one, or more parties to said automated negotiation (See Silverman Column 7 lines 25-30, ranking information includes relative performance); step of storing information is independent of any particular outcome of said automated negotiations (See Silverman Column 7 lines 25-30, storing entered bids and offers imply storing information independent of any particular outcome); information is stored on a relational database (inherent in the disclosure) or an object-oriented database (old and well known in the art).

***Response to Arguments***

6. Applicant's arguments with respect to claim 10 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft to The Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Application/Control Number: 09/717,783

Page 7

Art Unit: 3624

N. Subramanian

December 6, 2004

 12/7/04

Jagdish N. Patel

Primary Examiner